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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,311	09/26/2001	Noriaki Nada	MAT-8187US	1311

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RATNER AND PRESTIA
One Westlakes, Berwyn, Suite 301
P.O. Box 980
Valley Forge, PA 19482-0980

EXAMINER

REFAI, RAMSEY

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/963,311	NADA, NORIAKI	
	Examiner	Art Unit	
	Ramsey Refai	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>05/13/2002</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim recites the limitation "common function" in line 2. The applicant fails to disclose what this pertains to in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 7-8, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Borella et al (U.S. Patent No. 6,731,642).

6. As per claims 1, 8, 14, 15, and 16, Borella et al teach an Internet telephone system, apparatus, and method for making a telephone call through Internet, comprising:

- a) a first telephone set (**Figure 1, 24**);
- b) a first modem coupled to the first telephone set for communicating with the Internet (**Figure 1, 18**);
- c) a second telephone set (**Figure 1, 26**);
- d) a second modem coupled to the second telephone set for communicating with the Internet (**Figure 1, 20**); and
- e) a server connected to the Internet for storing a telephone number and an IP address corresponding to the telephone number (**Figure 1, 34 and column 6, line 61 – column 7, line 22**), wherein said first modem, after being assigned with an IP address, transmits a telephone number of the first telephone set and the assigned IP address to the server to register the telephone number (**column 7, lines 24-48**) and the assigned IP address in the server, and acquires an IP address corresponding to a telephone number of the second telephone set from the server, when the telephone number of the second telephone set is entered in the first telephone set, and then connects to said second modem (**column 8, lines 16-45**).

7. As per claim 2, Borella et al teach said first modem and said first telephone set include a common function (**Figure 1, 24 and 18; modem and telephone function as a internet telephony system**).

8. As per claims 7 and 13, Borella et al teach a host server of the server, wherein if an IP address of the server is a local IP address usable within a specific network, a unique IP address of the

server and the telephone number registered in the server are registered in the host server by relating to each other (column 7, lines 23-55; the server relates the caller station number with the caller address, the router and the gatekeeper).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borella et al (U.S. Patent No. 6,731,642) as applied to claim 1 above, and further in view of Thornton et al (U.S. Patent No. 6,363,065).

11. As per claims 3 and 9, Borella et al fail to teach said first modem communicates with said second modem through a public switching network if not replied from the server.

12. However, Thornton et al teach dynamically switching a call between callers a data network (IP network) using a first and second modem (**Figure 1**) to the PSTN in the event of a failure of an IP connection (**column 4, lines 12-22 and 44-53**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Borella et al and Thornton et al because Thornton et al's use of switching a call from an IP network to a PSTN would enhance Borella's system by allowing a caller on a internet telephony system to still connect to a callee on the IP network using the PSTN.

13. As per claims 4 and 10, Borella et al fail to teach said first modem communicates with said second modem through a public switching network if the IP address corresponding to the telephone number of the second telephone set is not received from the server.

14. However, Thornton et al teach dynamically switching a call between callers a data network (IP network) using a first and second modem (**Figure 1**) to the PSTN in the event of a failure of an IP connection (**column 4, lines 12-22 and 44-53**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Borella et al and Thornton et al because Thornton et al's use of switching a call from an IP network to a PSTN would enhance Borella's system by allowing a caller on a internet telephony system to still connect to a callee on the IP network using the PSTN when the caller fails to obtain an IP address from the database in the server.

15. As per claims 5 and 11, Borella et al fail to teach said first modem communicates with said second modem through a public switching network if not replied from the second modem when making a connection operation to the second modem by obtaining the IP address corresponding to the telephone number of the second telephone set from the server.

16. However, Thornton et al teach dynamically switching a call between callers a data network (IP network) using a first and second modem (**Figure 1**) to the PSTN in the event of a failure of an IP connection (**column 4, lines 12-22 and 44-53**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Borella et al and Thornton et al because Thornton et al's use of switching a call from an IP network to a PSTN would enhance Borella's system by allowing a caller on a internet telephony system to still connect to a

callee on the IP network using the PSTN when the caller fails to connect to a modem connected to callee.

17. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borella et al (U.S. Patent No. 6,731,642) as applied to claim 1 above, and further in view of Moon (U.S. Patent No. 5,864,758).

18. As per claims 6 and 12, Borella et al fails to teach said first modem stores registration information if not replied from the server after transmitting registration information to the server, and transmits the registration information again to the server to register the registration information in the server when the telephone number is entered in the first telephone set.

19. However, Moon teaches information is stored by the modem and retransmitted from one call-attempt to the next during a communications session (**column 8, lines 29 – 35**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Borella et al and Moon because Moon's use of a modem storing information and resending information during a call attempt would enhance Borella's system by allowing a modem to store registration information when an attempt to register at a server fails and resending the registration information during another call attempt which would save time by needing to acquire the registration information once more.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Cannon et al (U.S. Patent No. 6,735,209)

- b. Anderson et al (U.S. Patent No. 5,974,453)
- c. Kelly (U.S. Patent No. 6,347,085)
- d. Melen et al (U.S. Patent No. 5,956,391)

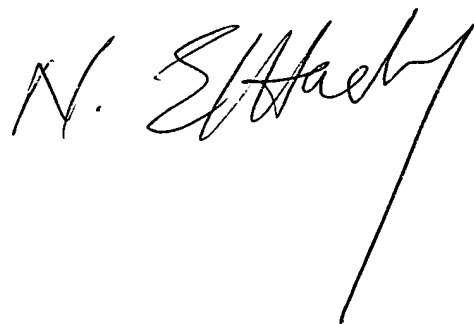
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
Art Unit 2154

RR
Ramsey Refai

A handwritten signature in black ink, appearing to read "N. S. Hach", with a long diagonal stroke extending downwards and to the right.